

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gerard Mourou et al.

Application No.: 09/775,069

Confirmation No.: 1906

Filed: February 1, 2001

Art Unit: 1725

For: METHOD FOR CONTROLLING
CONFIGURATION OF LASER INDUCED
BREAKDOWN AND ABLATION

Examiner: G. S. Evans

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action of August 28, 2012, a Notice of Appeal is filed herewith along with Applicant's Pre-Appeal Brief Request for Review. Applicant respectfully submits this Request for review of the issues discussed below.

I. STATUS OF CLAIMS

The office action rejects claims 46-67 under 35 U.S.C. § 251, as being broader than the claims of RE 37,585 F1. The office action rejects claims 46-67 based on estoppel in view of RE 37,585 F1 based on MPEP § 1449.01. The office action rejects claims 46-61, and 63-67 on grounds of non-statutory obviousness-type double patenting, in view of copending application Serial No. 09/775,106, in asserted combination with various references. The office action rejects claims 46, 47, 50, 51, 54, 55, 58-61, and 63-67 under 35 U.S.C. § 102, as anticipated by "Corneal Ablation by Nanosecond, Picosecond, and Femtosecond Lasers at 532 and 625 nm" D. Stern et al. (hereinafter "Stern"). The office action rejects claims 48 and 49 under 35 U.S.C. § 103, based on a purported combination of Stern, U.S. Patent No. 5,984,916 (hereinafter "Lai"), and Japanese Patent No. 62-93,095 (hereinafter "Nishiwaki"). The office action rejects claims 52 and 63-67 under 35 U.S.C. § 103, based on a purported

combination of Stern and Nishiwaki. The office action rejects claim 53 under 35 U.S.C. § 103, based on a purported combination of Stern, Nishiwaki, Lai, Japan Patent No. 5-42,383 (hereinafter “Arai”), and U.S. Patent No. 5,175,425 (hereinafter “Spratte”). The office action rejects claims 56, 57, and 62 under 35 U.S.C. § 103, based on a purported combination of Stern and Lai.

II. REMARKS THAT THE CLAIMED SUBJECT MATTER IS NOT ESTOPPED UNDER MPEP § 1449.01(B) and 35 U.S.C. § 251

The Examiner rejects claims 46-67 based on 35 U.S.C. § 251 and MPEP § 1449.01(B) and its suggested guidelines for handling concurrent reexamination/reissue applications.

- A. *MPEP § 1449.01 Would Not Have Applied to the Instant Application Because the Reexamination Was Not Concurrent with the Subject Reissue Application, which had issued 2 years prior.*

MPEP § 1449.01 pertains to situations in which a reexamination and concurrent reissue application are pending at the same time for the same patent, which is not the case here. Concurrence under MPEP § 1449.01 (then and now) pertains to the situation where a reissue application is pending at the same time a reexamination has been filed on the same patent, that is, on the same claims under reissue. MPEP § 1449.01 begins by citing 37 C.F.R. § 1.565(d), which discusses the ability to merge a pending reissue application and a co-pending reexamination. Merger stems from a desire for administrative economy, to prevent claims that are in the process of being corrected from defect, from separately, and at the same time, being held invalid or changed during reexamination. The overlap of the claims in the reissue application and the reexamination, therefore requires that “the patent owner will be required to place and maintain the same claims in the reissue application and the ex parte reexamination proceeding during the pendency of the merged proceeding.” 37 C.F.R. § 1.565(d). And any examiner actions and patent owner responses in the merged proceeding “will apply to both the reissue application and the ex parte reexamination proceeding and will be physically entered into both files.” *Id.* Were the reexamination and the reissue application not concurrent, as is the case here, then 37 C.F.R. § 1.565(d) would not be applicable to MPEP § 1449.01 and would not have been cited therein.

This framework, initially highlighted by MPEP § 1449.01 in regards to merged cases, equally applies when the reissue application and the reexamination were not merged. In providing examples of non-merger situations, MPEP § 1449.01 applies the same definition of concurrence as used for merger situations, i.e., that the same claims are under reissue and

reexamination at the same time. See, e.g., MPEP § 1449.01(B) (stating “where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed” and “where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.”) (Emphasis added).

In contrast to MPEP § 1449.01, in the instant case the ‘102 Reexamination was filed over two years after the reissued patent RE37,585. Application Serial No. 09/366,685 issued on March 19, 2002 as RE37,585; while Reexamination Application 90/007,102 was not filed until over two (2) years later, on June 25, 2004. There is no concurrence regarding the RE37,585 patent and the reexamination, i.e., no concurrent reexamination of the same claims. The ‘102 Reexamination could not have been merged with the reissue application, because the latter had already completed before the filing of the former, leaving 37 C.F.R. § 1.565(d) unavailable. Nor could one been stayed pending the other, for the same reason.

A few other points of note.

The instant application was filed as a divisional of the reissue application that led to RE37,585, with the view that the claims of the instant application were directed to an independent and/or distinct invention over that of RE37,585. The instant application is not a reissue of RE37,585, nor is it seeking to correct errors in the RE37,585.

The patent office records recognize the present application as a divisional application.

The examiner has never issued an double patenting rejection between the claims of RE37,585 and the instant application. Applicant filed a terminal disclaimer between the present application and RE37,585, but not in response to a double patenting rejection.

The only doubling patenting rejection in the file wrapper came after completion of the Reexamination and that double patenting rejection is between the instant application and another copending divisional application, U.S. Application Serial No. 09/775,106.

The claims of the instant application being independent and/or distinct from those of the RE37,585 could not have been introduced into the Reexamination Application 90/007,102.

B. Because the Claims of the Instant Application Could Not Have Been Added to the Reexamination Request, MPEP 1449.01(B) Does Not Apply.

MPEP § 1449.01(A) and (B) provide “guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination.” As MPEP § 1449.01(B) instructs, its guidelines do not apply where (a) the broader claims in the reissue application can be patentable, while claims in the reexamination are not; and (b) where the broader claims in the reissue application could not have been presented in the reexamination proceeding. See, MPEP §§ 1449.01(B)(3)(a) and (b).

Taking the exceptions in order, Applicant notes that the claims in the instant reissue application are different from those of the RE37,585 F1, and may indeed be patentable irrespective of the patentability of the claims at issue therein. In fact, the claims of the instant application had been deemed patentable over the prior art. Therefore, the first prong of the exemption applies.

For the second prong, the claims in the instant application could not have been presented in the reexamination proceeding, unless the instant application was merged with the reexamination proceeding, which it was not. Indeed, the Examiner took none of the actions listed in MPEP § 1449.01(B) to merge the instant application and the Reexamination Application 90/007,102. Furthermore, the claims of the instant application being claims of a divisional application and absent any *prima facie* showing by the examiner that these independent and/or distinct claims could have been introduced into the Reexamination Application 90/007,102, it would appear the rejection under MPEP § 1449.01(B) and 35 U.S.C. § 251 is improper for this reason as well.

C. There Has Been No Surrender of the Subject Matter of the Pending Claims.

The Court of Appeals for the Federal Circuit has set forth a three-step test for applying the recapture rule. *In re Clement*, 131 F.3d 1464, 1468-70 (Fed. Cir. 1997); *see, also* MPEP § 1412.02. The first step is to determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims – here that would mean the original claims in the reissue application that led to RE37,585. The second step is to determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution. The third step is to determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule. MPEP § 1412.02.

In concluding that the pending claims of the instant application go beyond the scope of the RE37,585 F1 reexamination, the Examiner points to the fact that the claims reference a “log-log” relationship between fluence threshold at which breakdown occurs, but not a relationship of fluence threshold at which breakdown occurs versus laser pulse width that exhibits a distinct change in slope as recited in various of the reexamined claims.

The Examiner’s analysis does not satisfy the second step of the recapture query, because neither the cited language missing from the claims nor the “log-log” language now added relate to subject matter surrendered as a result of the reexamination. The Examiner has established no connection with the claim language discussed in Para. 6 of the Official Action and that of any surrendered subject matter. The second step of the recapture query is not met. There has been no surrender regarding that subject matter.

D. Conclusion

In light of the foregoing, Applicant respectfully traverses the rejections of Paras. 5-7 of the Official Action.

Dated: February 28, 2013

Respectfully submitted,

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